

Remarks:

The pending claims at the time of the outstanding Office Action were claims 62-78, 113-127 and 136-137, and 139. By this amendment, Applicant has (1) amended claims 62, 64-65, 67-69, 71-76, 113-115, 117-119, 121-126, 137, and 139 as shown herein, and (2) canceled claims 66 and 116 without prejudice. The pending claims are now claims 62-65, 67-78, 113-115, 117-127, 137, and 139, of which claims 62 and 113 are Independent. No new matter is present. Exemplary support for the amendments to recite that steps and actions are performed by the server system during a single visit by the client system to the website can be found throughout the patent application (see, for example, Figure 3 and the process flow that would follow user selection of the “rent” button 292 shown in Figure 6D, as shown in connection with Figures 6F-L and 7A-C).

35 USC 112:

The Decision on Appeal found that claims 62 and 113 (and all claims dependent therefrom) were indefinite because of an alleged “internal logical inconsistency” with respect to the phrase “regardless of whether the user has a pre-existing master rental agreement”. (See Decision on Appeal dated February 7, 2013; page 9). The Decision on Appeal is clear that its conclusion regarding indefiniteness was predicated upon its interpretation of the term “master rental agreement” to mean an original rental agreement from which copies are made. (See Decision on Appeal; page 5, line 14 – page 6, line 9; page 9, lines 12-14 and lines 20-24).

However, as explained in the Second Declaration of David G. Smith submitted with this response pursuant to 37 CFR 1.132, the ordinary meaning of the term “master rental agreement” within the art is a rental agreement that serves to define the terms and conditions for several rental vehicle transactions over time rather than for only a single rental vehicle transaction. (See Second Declaration of David G. Smith; paragraphs 5-9). When the phrase “regardless of whether the user has a pre-existing master rental agreement” is interpreted using this correct interpretation of the term “master rental agreement”, it becomes clear that there is no internal logical inconsistency and that the phrase possesses a clear and unambiguous scope. (See Second Declaration of David G. Smith; paragraph 10).

Furthermore, the Office Action dated March 17, 2011 made the following statement to support an indefiniteness rejection of the phrase “regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental facility”:

It is known to one of ordinary skill in the art, rental car company has franchised their facilities, and, each franchisor can have their own rental agreement with local businesses. As currently claimed, it is not clear which pre-existing rental agreement (franchisee or rental car company) will be considered for generating a contract. (See March 17, 2011 Office Action; page 3).

Applicant notes that by their plain language, claims 62 and 113 are abundantly clear in scope as to what master rental agreements (MRAs) are recited in the claim. Claims 62 and 113 recite an MRA that is between the “user” and “a rental car company that operates the car rental facility”. Applicant respectfully submits that the nature of the “rental car company”, whether it be a franchisee or not, is immaterial to the scope of claims 62 and 113. These clauses in claims 62 and 113 address a pre-existing MRA that binds the user and the rental car company that operates the car rental facility.

Thus, to assess whether the “user has a pre-existing master rental agreement with a rental car company that operates the car rental facility” one needs to simply (1) identify the user, (2) identify the rental car company that operates the car rental facility at which the user is to arrive to pick up the subject rental vehicle, and (3) determine if there is a pre-existing MRA that binds these two parties with respect to rentals. Thus, if the rental car company that operates that car rental facility is a franchisee of a franchisor rental car company and where the user has an MRA with the franchisor rental car company such that this MRA does not operate to bind the franchisee rental car company that operates the subject car rental facility, then such an MRA would clearly outside the scope of the subject claim language. However, if the rental car company that operates that car rental facility is a franchisee of a franchisor rental car company and where the user has an MRA with the franchisor rental car company such that this MRA does operate to bind the franchisee rental car company that operates the subject car rental facility, then such an MRA is within the scope of the subject claim language. Of course, if the user has an MRA directly with the franchisee rental car company that operates the subject car facility, such an MRA would also be within the scope of the subject claim language.

Therefore, Applicant respectfully submits that the indefiniteness rejection of claims 62 and 113 must be withdrawn.

35 USC 103:

The Decision on Appeal found that independent claims 62 and 113 were obvious in view of the combination of the Hertz reference with the Avis reference and the HertzGold reference.

This obviousness determination by the Board was predicated upon several erroneous findings by the Board, which are addressed below.

First, the Board predicated its obviousness conclusion on the statement that “[c]ertainly all of the information necessary for the contract is in any reservation that a prudent car rental company would employ.” (See Decision on Appeal; page 11, lines 1-2). However, as explained at paragraphs 12-14 of the Second Declaration of David G. Smith, this statement by the Board is incorrect. In fact, “within the rental car industry, a significantly greater amount of information is necessary for a rental contract than that which is collected for a rental vehicle reservation.” (See Second Declaration of David G. Smith; paragraph 12). Moreover, as explained in the Second Declaration of David G. Smith:

A customer that has merely booked a rental vehicle reservation with a rental car company will not be permitted to pick up a rental vehicle and depart from the car rental facility with the rental vehicle. To actually be permitted to pick up a rental vehicle and depart from the car rental facility, the customer will need to enter into a rental contract (i.e., rental agreement) with the rental company. (See Second Declaration of David G. Smith; paragraph 12).

Thus, “[n]ot only are there fundamental and binary functional differences between a rental vehicle reservation and a rental contract (i.e., the customer is not permitted to depart the car rental facility with a rental vehicle pursuant to the former while he or she is permitted to depart the car rental facility with the rental vehicle pursuant to the latter), but different items of information and processing tasks are needed to complete rental contracts than rental vehicle reservations.” (See Second Declaration of David G. Smith; paragraph 14).

Given the failure by the Board to acknowledge these factual differences between a rental vehicle reservation and a rental contract within the rental car industry, the Board’s obviousness conclusion cannot stand because it is premised on a failure to properly assess the scope and content of the cited art, as well as a failure to ascertain the differences between the cited art and the claimed invention.

Second, the Board predicated its obviousness conclusion on a statement that:

There is no argument of technical infeasibility, or even difficulty in copying data from a reservation to a contract. It is not even necessary to copy data from a reservation – **the reservation itself may simply be subsequently recognized as a contract**. There is no patentable distinction between a reservation and a contract, **if they are otherwise the same**. (See Decision on Appeal; page 11, lines 2-7 (emphases added)).

With regard to this statement, Applicant first notes that “technical infeasibility” and “difficulty” are not the standards for assessing obviousness. Moreover, this statement by the Board further relies upon the incorrect factual underpinning that “all of the information necessary for the contract is in any reservation that a prudent car rental company would employ”. Once again, as explained in the Second Declaration of David G. Smith, “[n]ot only are there fundamental and binary functional differences between a rental vehicle reservation and a rental contract (i.e., the customer is not permitted to depart the car rental facility with a rental vehicle pursuant to the former while he or she is permitted to depart the car rental facility with the rental vehicle pursuant to the latter), but different items of information and processing tasks are needed to complete rental contracts than rental vehicle reservations.” (See Second Declaration of David G. Smith; paragraph 14). As such, reservations are not simply “recognized” as rental contracts, but rather additional data (relative to the reservation) is gathered from a customer to complete a rental contract. Moreover, given that rental vehicle reservations and rental contracts are not the same, the Board’s final statement as to the lack of “patentable distinction” is also inapplicable to the claimed invention. (See Second Declaration of David G. Smith; paragraph 15).

This error by the Board with regard to the factual underpinnings of its obviousness analysis is another reason why the obviousness rejection of the claims must be withdrawn.

Third, the Board stated that “[s]tatus of a document as a contract is perceptible only to the human mind and is therefore given no patentable weight.” (See Decision on Appeal; page 11, lines 7-9). Here again, this statement is contradicted by the facts. The rental vehicle reservation/rental contract distinction is not a mere difference in “non-functional descriptive material” (NFDM). As explained at paragraphs 12-15 of the Second Declaration of David G. Smith, there are important content differences and functional differences between a rental vehicle reservation and a rental contract. As to the functional differences, a customer is entitled to depart a car rental facility with a rental vehicle if there is a rental contract, but he or she would

not be entitled to do so with only a rental vehicle reservation. Given this stark functional difference, Applicant respectfully submits that the rental vehicle reservation and electronic rental contract language of the claims is entitled to patentable weight during examination.

Fourth, the Board states that “[i]t is unclear that Hertz actually requires members to be a Gold Club member to be able to bypass the rental counter.” However, this statement is wholly unsupported by any evidence of record in this patent application. As explained at paragraphs 16-17 of the Second Declaration of David G. Smith, a person skilled in the art who has reviewed the cited art and evidentiary exhibits from Applicant’s Appeal Brief dated April 16, 2012, it cannot be disputed that the Hertz and HertzGold references describe the counter bypass features as only being available to customers who are Gold Club members (i.e., customers with pre-existing MRAs). There is simply no discussion or indication that rental counter bypass is available to non-Gold Club members. Once again, this error by the Board with respect to determining the scope and content of the cited art is fatal to its obviousness determination. Furthermore, this error permeates the Board’s incorrect statement that the differences between the cited art and the claimed invention are merely marketing differences and not technical differences. (See Decision on Appeal; page 11, lines 10-18). As explained at paragraphs 18-19 of the Second Declaration of David G. Smith, there are substantial technical differences between the claimed invention and the cited references.

Moreover, amended independent claim 62 recites “wherein the electronically accepting, communicating, electronic rental contract creating and rental transaction storing steps are performed by the server system during a single visit by the client system to the website regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental facility.” Independent claim 113 has also been amended to recite this feature. By contrast, the cited references require a “two-touch” system, whereby a customer must first enroll in a rental program to create an MRA with the rental car company, and then later visit a website to leverage this MRA to book a rental vehicle transaction that permits the customer to bypass the rental counter during pickup. By contrast, the claimed invention is designed as a “one- touch” system to permit a user who has had no prior experience with a rental car company to visit a website and not only book a rental vehicle reservation with the rental car company but also create the recited “electronic rental contract” during the same website visit, such that this electronic rental contract permits the user to avoid

creating a rental contract at the rental counter when arriving at the car rental facility to pick up a rental vehicle in accordance with the electronic rental contract. The cited references not only provide no guidance on how to design such a method/system, but they also teach away from the invention of claims 62 and 113 because of their requirement of the pre-existing MRA, the precise opposite of that which is recited by claims 62 and 113.

Therefore, Applicant respectfully submits that amended claims 62 and 113 (and all claims dependent therefrom) are patentable over the cited references. Applicant further submits that the dependent claims are also independently patentable over the cited references. For example, claims 74-76 and 124-126 recite various validation operations that are performed on additional data provided by the user during the single visit to the website. The cited references fail to describe, teach, suggest, or even contemplate the performance of such validation operations during the single visit to the website. As such, Applicant respectfully requests that the obviousness rejections of the claims be withdrawn.

Conclusion:

For the foregoing reasons, Applicant respectfully submits that all pending claims are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Furthermore, Applicant believes that this amendment and remarks are sufficient for overcoming the rejections raised by the Decision on Appeal and the Office Action from which appeal was sought. However, should Applicant later need to further respond to these or new claim rejections, Applicant reserves the right to fully respond to these and any other new rejections, including but not limited to further amending the claims and/or adding new claims, submitting evidence in favor of the patentability of the claims, disputing the alleged prior art status of the cited references if warranted, and presenting new reasoning in favor of patentability. Moreover, in submitting this response, Applicant does not acquiesce to any characterizations of the claims or art (including any characterizations about what is allegedly known in the art) made in the Decision on Appeal or the Office Action from which appeal was sought.

Application No. 09/698,502
Attorney Docket No. 51017-79635

A speedy and favorable action is respectfully requested.

Respectfully submitted,

/Benjamin L. Volk, Jr./
Benjamin L. Volk, Jr.,
Reg. No. 48,017
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101-9928
(314) 552-6352 (phone)
(314) 552-7352 (fax)